

Application No.: 10/522,078
Filing Date: July 5, 2005

REMARKS

In the Office Action dated July 22, 2010, Claims 1-5, 7-9, 11, 12, 14, 15, 17-20, and 24-27 were rejected. By this paper, Applicant has amended Claims 1 and added new Claims 28 and 29. The amendments to the claims are supported at least by page 17 and Figures 2 and 7 of the originally filed specification. Applicant respectfully requests reconsideration of the application in view of the amendments set forth above and the remarks set forth below.

Discussion of the Rejection under 35 U.S.C. § 112, First Paragraph

Claim 26 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully submits that, as stated in the M.P.E.P. at § 2163.02, a claim satisfies the written description requirement of 35 U.S.C. § 112, first paragraph, if the specification “reasonably conveys to the artisan that the inventor had possession” of the claimed invention when the application was filed. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985).

Claim 26 recites “the front surface has a bevel angle between 5 and 10 degrees.” The specification as originally filed states “In this embodiment [of figures 2 and 3], a bevel angle α of up to 5° is selected. For larger bevel angles, one of the embodiments according to figures 5 to 8 is preferably selected. In these, the bevel angle α is preferably up to 10°.” *Specification* at p. 17, lines 23-28. Thus, the specification discloses embodiments having a bevel angle up to 5 degrees, and other embodiments “for larger bevel angles” than 5 degrees which have a bevel angle up to 10 degrees. Thus, the specification discloses bevel angles larger than 5 degrees and up to 10 degrees, or “between 5 and 10 degrees” as recited in Claim 26.

Because the originally filed specification “reasonably conveys to the artisan that the inventor had possession” of the feature of a bevel angle between 5 and 10 degrees, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

Discussion of the Claim Amendments

Claim 1 has been amended to recite, among other things, “a stripping element which surrounds the cutting element, wherein the stripping element has a non-circular cross-section and a front surface including a beveled portion which comes into contact with the workpiece and

remains beveled at least when the cutting element passes through the workpiece.” In particular, Claim 1 has been amended to clarify that it is the beveled portion of the front surface which contacts the workpiece. Applicant respectfully submits, as detailed below, that the applied art does not include such a feature. Figure 1 of the present application, reproduced on the following page, illustrates a punch in which the “front surface 7 of the stripping device 3” contacts the workpiece. *Specification* at p. 14, lines 4-5. As shown, “the stripping device has a front surface which has a front surface shape which corresponds to the shape” of the workpiece. *Id.* at p. 14, lines 13-15. In one embodiment, “shaping of the front surface can be undertaken on-site at a particular user” or performed beforehand based on provided specification. *Id.* at p. 14, lines 16-18.

Figure 2 of the present application, also reproduced on the following page, shows a “longitudinal sectional view of a first embodiment of a stripping device 3.” *Id.* at p. 14, lines 30-31. Added to the figure in this response is a boxed number 7 referencing the front surface of the stripping element that would result after the “front surface of the stripping element 15 is beveled or shaped.” *Id.* at p. 17, 17-19. In one embodiment, the “further shaping of the front surface of the stripping element 15 is preferably matched to the shaping of the workpiece.” *Id.* at p. 17, lines 28-30.

A device having a stripping element with a front surface which is beveled or shaped in accordance with the shape of the workpiece provides a number of advantages. For example, in such cases it is “possible, by means of this matching, to avoid inadvertent marking caused by the stripping element on the surface of the punched workpiece. Such markings, in particular circular markings, regularly occur in the case of the devices of the prior art and lead to a reduced quality of the punched workpieces or to wastage.” *Id.* at p. 17, lines 31-37.

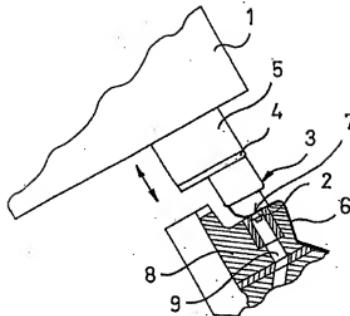


Fig. 1

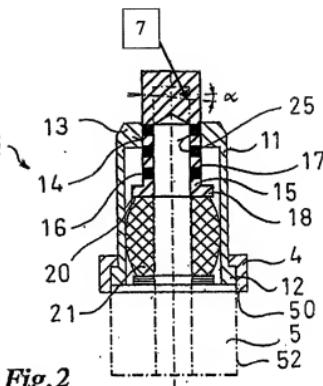


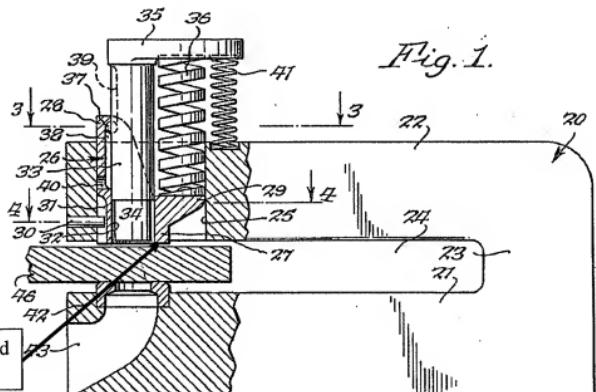
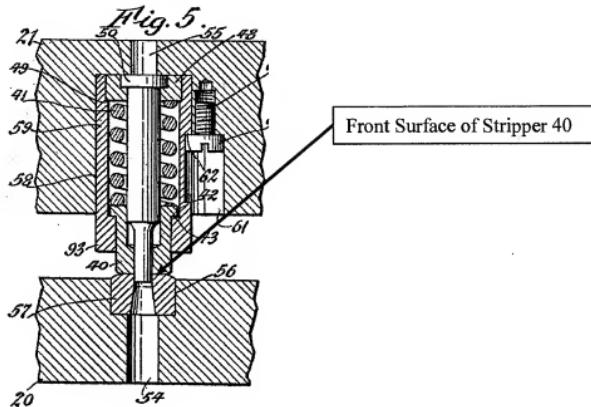
Fig. 2

Discussion of Rejection under 35 U.S.C. § 103(a)

Claims 1-5, 7-9, 11, 12, 14, 15, 17-21, and 23-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wales (U.S. Patent No. 2,168,377) in view of Taylor (U.S. Patent No. 2,760,574) in further view of Vlahek (U.S. Patent No. 4,428,262), Hugo (U.S. Patent No. 4,246,815), and Blais (U.S. Patent No. 3,465,634). Applicant further submits that, as stated in the M.P.E.P. at § 2143, “The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.” *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007).

As noted above, Claim 1, as amended, recites, for example, “the stripping element has a non-circular cross-section and a front surface including a beveled portion which comes into contact with the workpiece.” Applicant respectfully submits that none of the applied references discloses this feature. As shown in Figure 5 of Wales, reproduced below, the front surface of stripper 40 which contracts the sheet is flat and perpendicular to the axis along which the punch moves; it is not beveled as that term is used in Claim 1. Similarly, as shown in Figure 1 of Taylor, the front surface of the lower end 27 of the stripping element 26 which contacts the work-

piece 46 is flat and perpendicular to the axis along which the punch moves; it is also not beveled as that term is used in Claim 1.



In the Office Action, the Examiner agreed that "Wales does not disclose wherein the front surface of the stripping element is beveled." However, the Examiner stated that "it is well known in the art for breaking the sharp edge as a safety measure." *Office Action* at p. 5. The Examiner further stated that Vlahek, Hugo, and Blais "also disclose punching machines that

utilize a stripping element" having beveled surfaces. Applicant respectfully submits that Vlahek, Hugo, and Blais do not cure the deficiency noted in Wales and Talyor.

Vlahek, as shown in Figure 3 (below, left) discloses a stripper wherein the "outer surface of an end wall is slightly convex and beveled at its outer periphery." *Vlahek* at col. 1, lines 52-54. Vlahek also discloses that the end wall is the portion of the stripper which "engages with the material 16." *Id.* at col. 1, lines 56-57. However, as can be seen in Figure 3, the portion of the end wall 12 that contacts the material 16 is not beveled as that term is used in Claim 1, rather the end well 12 is flat and entirely perpendicular to the axis along which the punch 14 moves. Hugo, as shown in Figure 2 (below, right), similarly discloses that only a flat and perpendicular portion of annular insert 50 contacts the workpiece W.

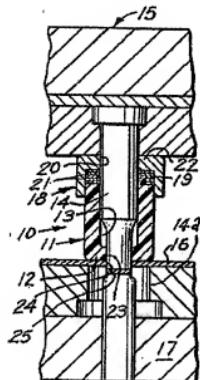


FIG. 3

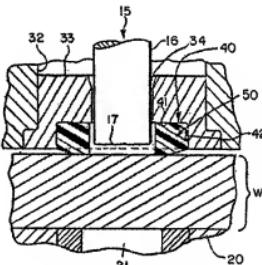


FIG. 2.

Blais, as shown in Figures 1 and 2 (below), discloses a system in which a "punch face 22 of the punch 21 is, in the form shown, angularly arranged with respect to the longitudinal axis of the cylinder 21 to provide an upward beveled face 25 thereon." *Blais* at col. 3, lines 17-20. Applicant respectfully submits that the punch disclosed by Blais is not a "stripping element" as recited in Claim 1. Blais further discloses a "stripper 30" illustrated in Figure 2 with a flat face entirely perpendicular to the "longitudinal axis" along which the punch moves.

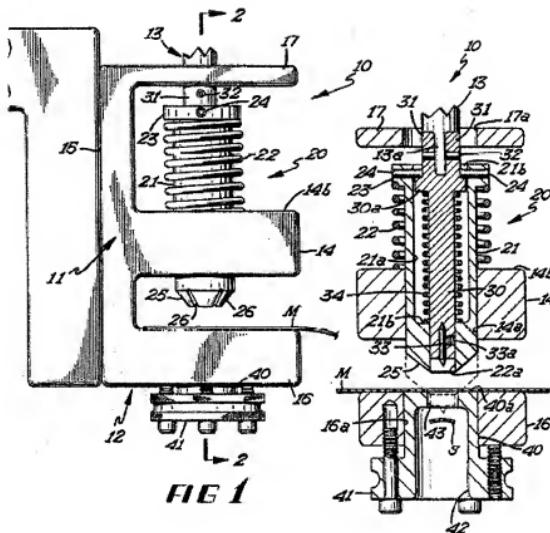


FIG 1



In view of the above, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to the pending claims and Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a).

Discussion of New Claims

Claims 28 and 29 depend on Claim 1, which is allowable for the reasons set forth above. In view of the patentability of its base claim, and in further view of its additional technical features, Applicant respectfully submits that Claims 28 and 29 are patentable over the applied prior art.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims, and that those claims are in

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condition for allowance. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

The undersigned has made a good faith effort to respond to all of the noted rejections and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if an issue requires clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve any such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 10/21/10

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